

REMARKS

As amended, Claims 1-6, which are presently in the application avoid or overcome the claim rejections, which are as follows. Claims 2-6 stand rejected as being indefinite for reciting the broad and preferred embodiments of the claims. Claims 1, 3-6 stand rejected as being non-enabled by the specification. Claims 1-6 stand rejected under 35 USC 103(a) as being unpatentable over Wearing et al, GB 1,038,945 (Wearing).

By the above amendments, Applicants have overcome the 35 USC 112, paragraph 1 rejection of Claim 2-6. By the following remarks, Applicants show how they avoid the rejection of the claims as being non-enabling under 35 USC 112, and as being obvious over under 35 USC 103. Applicants' remarks can be summarized as follows. With regard to the non-enabling rejection, Applicants submit that the specification as filed contains sufficient information regarding the subject matter of the claims including dye, which would enable the skilled artisan to make or use the same. With regard to the obviousness rejection, Applicants submit that when the total difference between the prior art and the claims is ascertained, it becomes quite clear that the claims are patentably distinct.

The 35 USC 112 rejection is based on the grounds that:

"....the specification, while enabling for vat dyes, does not reasonably provide enablement for any other reduced dye which may be converted by oxidation to colored form. The specification does not enable any person skilled in the art to which pertain, or with which it most nearly connected, to make and use the invention commensurate in scope with these claims. For example, there is no enablement for dyeing with sulfur dyes or oxidation dye bases as are normal used in permanent hair coloration".

The Examiner is arguably correct with regard to a broad usage of the term "dye". In this case however, the term dye is characterized so specifically that the skilled artisan can ascertain, make and use the same in accordance with the invention. More specifically, at page 5, lines 7-9 of the captioned application, the term dye is characterized as:

"....an alkaline dye liquor containing at least one dye which has been previously converted into an alkali-soluble form by chemical reduction and which can be converted into its insoluble form by oxidation;...."

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As characterized, it is open to question as to whether sulfur dyes or oxidation dye bases would fall within the dyes as characterized. At any rate, inoperative embodiments of the invention relating to the use of sulfur dyes would not necessarily render process non-enabled, since the skilled artisan can readily ascertain whether said dyes fall within the above characterization, Atlas Powder Co. v. E.I. du Pont de Nemours & Co 224 USPQ 409 (Fed. Cir. 1984).

The test here is whether the skilled artisan would have to resort to undue or unreasonable experimentation in order to ascertain how to make or use the claimed invention. Applicants submit that the disclosure as filed complies with undue experimentation (Wand) factors. Namely, the breadth of the claims is readily ascertainable. The level of skill and the nature of the invention are well known. The materials used in the process are well known and the specification provides representative examples. Based on the knowledge in the art and disclosure of the specification, there is sufficient guidance to the skilled artisan on employing the process with particular reference to the dyes used therein.

Seemingly, the non-enablement rejection is based on the grounds that the scope of dyes of the claims is such that the skilled artisan cannot ascertain, make and use the dyes recited by the claims. To the contrary, the following description of the dyes as found in the captioned application would show that the skilled artisan can ascertain the scope of the useful dyes. The claimed process falls within the well established field of producing dyed wrappings for food, in particular skins made of cellulose fiber, having high transparency and evenness of the dye for the claimed process. See the captioned application at page 1 lines 1-6. Dyeing in the field of the invention and in particular cellulose fiber is known in the art. See the captioned application at page 1, lines 25-27. The object of the present invention is to provide a process for producing dyed tubular food wrappings made of non-woven fabric coated with regenerated cellulose, particularly skins of cellulose fiber having light transparency and evenness of the dye which can be carried out at low industrial expense. See the captioned application at page 4, lines 20-23. The skilled artisan would select the dyes as described at page 5, lines 15-21 and page 8, lines 5-24.

As such, the nature of the invention, and the state of the art is such that the skilled artisan would ascertain the useful dyes for the process. It is well established that where the specification discloses at least one method for making and using the claimed invention that bears a reasonable correlation to the entire scope of the claim, then the enablement requirement of the 35 USC 112, is satisfied. In re Fisher 166 USPQ 18 (CCPA 1970). Therefore, it would be within the purview of the skilled artisan to make or use the dyes suitable for this field. In view of the foregoing, Applicants submit that the specification provides sufficient information enabling the skilled artisan to make and use the invention, In re Wand 8 USPQ2d 1400 (Fed. Cir. 1988). Applicants therefore pray for the withdrawal of the rejection for lack of enablement.

The rejection of Claims 1-6 under 35 USC 103(a) as being unpatentable over Wearing et al is based on the grounds that:

"Patentees disclose a method of producing colored speck-free cellulosic films formed from viscose (p1, lines 16-17). They are used for making seamless regenerated cellulose tubing, with or without fibrous web imbedded therein, used for the processing and packaging of meat products. See page 6 lines 19-23 and 69-80."

In comparing the above to the claims, the Examiner states that:

"Applicant claims a method of producing dyed, tubular food wrappings from non-woven fabric coated with colored cellulose by a process of forming the leuco solution of a vat dye, mixing with viscose solution, and coagulating and regenerating the cellulose, and oxidizing the leuco dye. Patentee teaches at page 1, lines 50 et seq.,...."

The Examiner then cites the following negative disclosure from the patent, as teaching the claimed invention. The negative disclosure states that:

"Adding a vat dye in the form of a leuco solution, i.e. reduced and solubilized, to viscose prior to extrusion also has not produced satisfactory results. That sentence teaches applicant's process except for the step of coating a non woven fabric with the colored solution. It would have been obvious to the skilled artisan that the viscose solution colored with the vat dye as cited above is used to coat a fibrous web for the production of meat wrappings because patentee states that that is the intended use of the colored viscose solution. Since page 6 lines 19-23 disclose that said colored cellulose is generally used with a fibrous web imbedded therein, all of the elements of applicant's claims are disclosed."

Contrary to the Examiner's assertion, it seems to Applicants that given the negative disclosure, the skilled artisan would not have been motivated to modify Wearing's teachings to the claims. It is well established in the law that the fact that a reference can be modified to the claims does not render the claims obvious, absent some basis in the reference or the general knowledge in the art which would have led the skilled artisan to make the modification, In re Mills 16 USPQ2d 1430 (Fed. Cir. 1990). The record fails to assert a basis for the modification. As such, Wearing is insufficient as a basis for a prima facie case of obviousness. Therefore, Applicants pray for the withdrawal of the 35 USC 103 rejection.

For completeness of response, Applicants address the antecedent issue of the extent of the Examiner's finding of the difference between the prior art and the claims. From the foregoing, it appears that the Examiner's finding of the difference between the prior art and the claims is limited to the step of coating a non-woven fabric with the colored solution. Applicants submit that claimed invention differs from the prior art in other respects, and when the total difference is ascertained, it becomes quite clear that the claims are patentably distinct.

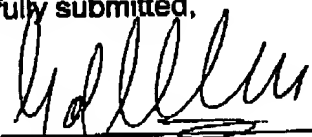
Wearing et al further differs from the claims in that it relates to a process for producing colored cellulose film and not cellulose fiber skins. It is of note that in the process of Wearing, the reduction of the vat dye with dithionite in the heated viscose is carried out continuously for 30 minutes. Secondary reaction of the powerful reducing agent with the viscose, which lead to gel-formation and blockage of the extrusion dies, probably occurs in this process.

In contrast, in accordance with the claimed invention, the reduction is carried out without using the less potent sodium sulfite in order to avoid the aforementioned secondary reactions. Carboxymethyl cellulose is necessary for the subsequent transparency. Other thickeners were not effective.

Given the differences, which are not suggested by the references,
Applicants submit that the claims are patentably distinct and pray for their allowance.

Respectfully submitted,

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